

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of

John M. CARNAHAN, III

Art Unit: 3643

Serial No.: 10/743,380

Examiner: Parsley, D. J.

Filed: December 23, 2003

For: METHOD AND DEVICE FOR DETECTING FISHING CONDITIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In connection with the Notice of Appeal filed concurrently herewith, Appellant wishes to have a review of the factual and legal bases for the final rejection of the claims based on Flynn and Crane by a panel of three Examiners (the Panel).

In review, claims 1, 2, 4, 7, 9, and 10 stand rejected under 35 U.S.C. § 102(b) based on United States Patent No. 5,722,196 to Flynn. Claims 8 and 11 stand rejected under 35 U.S.C. § 103(a) based on Flynn when taken in view of Crane.

Claim 7 of the application defines a frame with a pair of side rails, and a flexible screen having its opposing sides aligned with and attached to a respective side rail.

The Examiner alleges that this feature is taught in Flynn because the net 52 of Flynn is allegedly attached to the members 16 and 18, which are considered by the Examiner to read on the claimed side rails. The Examiner relies on col. 5, lines 36-41 to support his position.

It is respectfully submitted that the Examiner's interpretation of the teachings of

Flynn is factually incorrect. The Panel's attention is directed to col. 4, lines 63 and 64 and col. 5, lines 34 and 35 of Flynn. Each of these sections of Flynn teaches that the screen is attached to the vertical members 12 and 14. This is reiterated in col. 8, lines 20 and 21. These disclosures make it quite clear that the net 52 of Flynn is attached to the pivoting members 12 and 14. This interpretation is the only one that makes sense since it is the members 12 and 14 that are placed upright to orient the net 52 for aquatic sampling.

One issue on this appeal relates to the sentence relied upon by the Examiner, which is reproduced below

Said assembled aquatic seine device 10 with said attached flexible net 52 is placed in said running water to be sampled by having said plurality of two parallel L-shaped horizontal members with said attached flexible net 52 facing into said running water....

The Examiner contends that "horizontal members with said attached flexible net 52" means that the net 52 is attached to the members 16 and 18. It is submitted that a fair reading of the entire Flynn disclosure means that "said attached flexible net 52" refers to the previous mention of the attached net, which is found in col. 5, lines 34 and 35, and this teaches that the net is attached to the members 12 and 14. The interpretation that the net 52 is attached to the members 12 and 14 is supported by three separate disclosures as noted above. There is no teaching whatsoever in Flynn to confirm that the phrase "said attached flexible net 52" means that the net is attached to the members 16 and 18. The Examiner is ignoring the rest of Flynn to draw the conclusion that somehow the net 52 is attached to members 16 and 18.

Moreover, the phrase "said attached flexible net 52" is used first in line 37, and this clearly would reference the previous sentence stating that the net 52 is secured to the members 12 and 14. There is nothing to suggest that the second recitation of this phrase

on line 40 would somehow have a different interpretation, i.e., the net is now secured to members 16 and 18.

In addition, Figures 1 and 4 show that the net 52 must be attached to the members 12 and 14 to allow it to unfurl. Therefore, the Examiner's cannot ignore the fact that regardless of the question of attachment to members 16 and 18, Flynn teaches that the net must be attached to both members 12 and 14. This also weighs against the conclusion that the net 52 is attached to members 16 and 18.

Col. 5, lines 1-6 describe the net 52 as removable from the device components. If the net has to be removed, why would it be attached to the lower members when no function or teaching is provided as to why such an attachment is needed? The fact that there is no explanation of why the net 52 needs to be attached to the members 16 and 18 further substantiates Appellant's contention that the net 52 of Flynn is only attached to the members 12 and 14.

It is respectfully submitted that the Examiner's interpretation of the teachings of Flynn is incorrect, and Flynn does not teach a flexible screen with its opposing sides aligned and attached to the side rails as set forth in claim 7. Lacking this claimed feature, the rejection based on 35 U.S.C. § 102(b) is improper.

It is also contended that Flynn does not teach the insertion step of claim 1. Claim 1 requires that one or more support portions of the frame are embedded in a bed underlying the water as part of the insertion step. This is not a functional limitation in an apparatus claim even if the "embedded" in claim 1 is used in past tense. Claim 1 is a method claim wherein the embedding step is part of the insertion step. It is error for the Examiner to ignore the embedding limitation of claim 1, and this is grounds for

withdrawing the rejection or reopening prosecution.

The Examiner also contends that placing the rock on the cross bar causes an embedding of a support portion of the frame. This position fails since laying the members 16 and 18 and cross bar on a bed, even if weighted, is not the same as embedding the one or more support portions in a bed as part of the insertion step of placing the frame into shallow water. Moreover, Appellants contend that the step of embedding is more than laying the device of Flynn in a bed that may have a sandy bottom; this is not embedding. Therefore, the rejection of claim 7 is also in error.

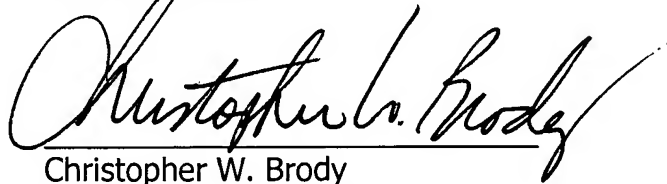
Lastly, the rejection of claims 8 and 11 is in error. The mere fact that Crane has a pivotal connection does not lead to the conclusion made by the Examiner that it would be obvious to make the cross members of Flynn into two pivotal parts. While the Examiner contends that members 3 and 6 of Crane are pivotally attached together, member 6 is attached at a midpoint of member 3. Claim 8 requires that each segment has one end pivotally attached to the side rail with each of the other ends of the segments attached together. Crane teaches no such arrangement and this along with its totally different member movement has no relevance with respect to the single cross bar of Flynn. Therefore, the rejection of claims 8 and 11 is also in error.

It is respectfully submitted that the Examiner has not made a *prima facie* case of anticipation against claim 1 and 7. Moreover, the teachings of the secondary reference to Crane do not make up for the deficiencies in Flynn to support a rejection of these claims under 35 U.S.C. § 103(a). Lastly, the rejection of claims 8 and 11 must also be withdrawn on the basis that the Examiner has failed to establish a *prima facie* case of obviousness.

In light of the above, Appellant respectfully requests that the Panel either direct the Examiner to allow this application or reopen prosecution since the rejections are improperly made.

No fee is necessary in submitting this paper, but in the event that some fee is due in connection with this filing, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", written over a horizontal line.

Christopher W. Brody
Registration No. 33,613

Customer No. 22902
1090 Vermont Ave. NW
Suite 250
Washington, DC 20005
Telephone: 202-835-1111
Facsimile: 202-835-1755
Docket No.: 12104-0002
Date: September 16, 2005